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Attorney Docket No. SAA-34-2 (402P230)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
RAINER H. WISCHINSKI)	
)	
Application No. 09/635,280)	Examiner: David R. Lazaro
)	
Confirmation No. 4936)	Art Unit: 2155
)	
Filed: August 9, 2000)	
)	
For: METHOD AND APPARTUS FOR)	
PROGRAMMING AN AUTOMATION)	
DEVICE)	

APPELLANT'S REPLY TO THE EXAMINER'S ANSWER

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

Appellant submits this Reply to the Examiner's Answer. Under 37 C.F.R. 41.41, this Brief is due on September 26, 2006, two months from the mailing date of the Examiner's Answer of July 26, 2006 . This Reply is therefore timely filed.

I. APPELLANT'S REPLY

The response to Appellant's arguments section of the Examiner's Answer does not take into consideration the complete scope of the presently claimed system and method. Additionally, the response does not clearly establish how the cited art renders the claimed system or method obvious, or how one skilled in the art would be motivated to combine the references in the manner suggested.

The Examiner maintains that the portions of Nixon relied upon by Appellant to show a distinction between Nixon and the present invention, only establish that a user is involved in creation or generation of the customized programs, and not in the selection. (Examiner's Answer, p. 16). The Examiner further asserts that even under an interpretation where the user selects the programs, "the claim language does not exclude such functionality" and "the teachings of Nixon are still within the claimed subject matter." (Examiner's Answer, pp. 17-18). In making this response, the Examiner ignores claim limitations in the present application and fails to show how Nixon (or Nookala) meets such limitations.

As exemplified in claim 1, the present system includes an automation device, a network device, connected to a network. Moreover, claim 1 requires "a plurality of customized application programs for the automation device stored in the network device, **wherein one customized application program of the plurality of customized application programs controls the automation device, and is selected by the network device in response to a specific application program request message for the one customized application program received at the network device** and sent from the automation device as part of a bootstrap protocol." (Emphasis added).

Nixon does not disclose a system or method which includes a network device that selects one customized application program from a plurality of such programs in response to a specific message from the automation device requesting that one application program. The only disclosure in Nixon, is that a user determines which application program is to be downloaded to the automation device. There is no disclosure in Nixon of the automation device identifying a specific program and specifically requesting such program.

Contrary to the Examiner's alternate position, Nixon is not within the scope of the claimed subject matter. That is, user selection of the program "in response" to an automation request is not what is being claimed. It is clear from the claim language that the automation device of the present application is determining and identifying which program the network device selects and downloads, not a user. Such user selection would be unnecessary and superfluous given the specific request for a particular application program by the automation device of the present invention. In any event, Nixon does not teach the automation device providing such a specific identification.

Nookala does not cure the problems of Nixon. There is no disclosure in Nookala of an automation device that requests a particular customized application program from a plurality of such programs. That is, because Nookala does not disclose whether more than one program is stored for selection, it also fails to disclose whether the request by the second device is for a particular one of a plurality of application programs.

The Examiner maintains that he is relying on Nixon for disclosure of the plurality of programs. However, if Nixon does not disclose an automation device request for a particular program of a plurality of programs, and Nookala does not disclose an automation device request for a particular program from a plurality of programs, then the combination also fails to provide this claim limitation.

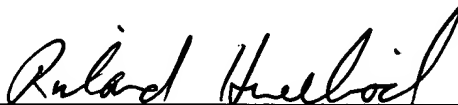
In addition to the failure of the references to teach each of the limitations of the claimed invention, there is still no adequate showing of an incentive or motivation to combine the references in the manner suggested by the Examiner. There is nothing in the references, or elsewhere in the prior art, to suggest modifying Nixon in a manner so that the network device selects one of a plurality of applications in response to a request from an automation device for the specific one application.

II. CONCLUSION

Accordingly, for the reasons given above, and those set forth more fully in Appellant's Appeal Brief, Appellant respectfully requests an order reversing the pending rejections of claims 1-17, 19-21 and 23 and allowing these claims to pass to issue.

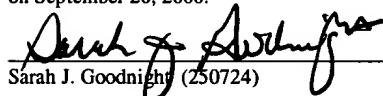
Respectfully submitted,

Date: September 26, 2006

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CERTIFICATE OF MAILING

I hereby certify that this correspondence and fee are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: MAIL STOP APPEAL BRIEF - PATENTS, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on September 26, 2006.


Sarah J. Goodnight (250724)